

REMARKS

Claims 1-5, 7, 9-11, 13, 15-17, 33-40 and 42-48 are pending in the present Application.

Claims 1-5, 7, 9-11, 13, 15-17, 33-40 and 42 have been canceled without prejudice in order to expedite allowance of the instant application. These exact claims are being re-filed as a continuation application. The claims all require that the coating penetrates the first fiber mat from the first side into the fiber mat to a depth of about 30 percent to about 50 percent of the thickness of the fiber mat. Applicants maintain that this is a key element that is not taught or suggested in the prior art. Since this issue is one that may ultimately need to be appealed to the Board, Applicants elect to pursue these claims in a separate application and prosecute claims with additional patentable limitations in the instant application.

Claims 49 and 50 have been added, leaving claims 43-50 for consideration upon entry of the present Amendment.

Antecedent basis for new Claims 49-50 can be found at least as follows.

Claim 49: Claim 1, paragraphs [39], [43], [45] and [83].

Claim 50: Paragraph [83].

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Statement Concerning Common Ownership

Application serial number 10/798,891 (instant application) and 10/957,745 (Currier et al. reference) were, at the time the invention of Application serial number 10/798,891 was made, subject to an obligation of assignment to Georgia-Pacific Gypsum Corp. (now Georgia-Pacific Gypsum LLC).

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1-5, 7, 9-11, 13, 33, 35-40 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282, hereinafter "Randall") in view of Ali (U.S. Patent No. 4,647,486) and further in view of Currier et al. (U.S.

2005/0266225, hereinafter “Currier”).

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali and Currier and further in view of Babcock et al. (U.S. Patent No 4,746,365, hereinafter “Babcock”).

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali, Currier, Babcock, and further in view of Miyakoshi (U.S. Patent No. 5,827,788, hereinafter “Miyakoshi”).

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali and Currier, and further in view of Kennedy et al. (U.S. 5,484,653, hereinafter “Kennedy”).

Claims 1, 10 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush et al. (U.S. 2003/0134079, hereinafter “Bush”) in view of Ali and further in view of Currier.

These rejections are moot as Claims 1-5, 7, 9-11, 13, 33, 35-40 and 42 have been canceled without prejudice.

Claims 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauber et al. (U.S. 6,524,679, hereinafter “Hauber”) in view of Bush and further in view of Currier.

As noted in the Office Action (Page 3), the rejections employing the Currier reference may be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See 35 U.S.C. 103 (c), MPEP 706.02(l)(1) and 706.02(l)(2). As noted in the clear and conspicuous statement above, Application serial number 10/798,891 (instant application) and 10/957,745 (Currier et al. reference) were, at the time the invention of Application serial number 10/798,891 was made, subject to an obligation of assignment to Georgia-Pacific Gypsum Corp. (now Georgia-Pacific Gypsum LLC). Therefore, Currier is now disqualified as prior art and must not be used in a 35 U.S.C. 103(a) obviousness rejection. Accordingly, this rejection employing Currier should be withdrawn.

Claims 1-5, 7, 9-11, 13, 33, 35-40 and 42 stand rejected under 35 U.S.C. § 103(a)

as being unpatentable over Randall in view of Ali and further in view of Schlachter (U.S. Patent No. 6,077,593, hereinafter “Schlachter”).

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali and Schlachter and further in view of Babcock.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali, Schlachter, Babcock, and further in view of Miyakoshi.

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall in view of Ali and Schlachter, and further in view of Kennedy.

Claims 1, 10 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush in view of Ali and further in view of Schlachter.

These rejections are moot as Claims 1-5, 7, 9-11, 13, 33, 35-40 and 42 have been canceled without prejudice.

Claims 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauber in view of Bush and further in view of Schlachter.

In making the rejection, the Office Action correctly notes that Hauber “fail to teach that the first coating and the second coating penetrating the first and the second fiber mats penetrate at a depth of about 30 percent to about 50 percent of the thickness of the fiber mats as required by claims 43 and 46.” (O.A., page 32). Rather, the Office Action relied upon the combination of Hauber with Bush to cure this deficiency of Hauber. Applicants respectfully submit that combination of Hauber with Bush and Schlachter fail to establish a *prima facie* case of obviousness.

Hauber, when considered as a whole, appears to be suggesting the importance of gypsum slurry penetrating completely thru the mat. For example, Hauber teaches that “ideally, the high density gypsum 38 is forced to penetrate 100% through the glass mat sheet 14, although manufacturing tolerances may permit penetration of approximately 95-98%.” (Col. 7 lines 36-39). Hauber teaches that “it has been found desirable to form a thin film of slurry on the outer face surface of the glass mat, to avoid exposed fibers of glass, and so to present a smooth working gypsum board surface that can be handled by construction workers.” (Col. 2, lines 1-4). A person of ordinary skill in the art would have to disregard the entire teachings and advantages suggested by Hauber and make a gypsum board by a completely different process in order to use the glass-mats taught by

Hauber with Bush, when there is not motivation to do so. For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and requests that the rejection of Claims 43-48 be withdrawn.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with the undersigned would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fees be charged to Deposit Account No. 50-3313.

Respectfully submitted,

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